REMARKS

The Office Action dated June 22, 2006, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-46 are currently pending in the application, of which claims 1 and 24 are independent claims. Claims 1-46 are respectfully submitted for consideration.

Rejections under 35 U.S.C. 112, second paragraph

Claims 1-2, 4, 6-9, 13, 16, 22-25, 27, 29-31, 36, and 39 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Office Action indicated that claims 1-2, 4, 6-9, 13, 16, 22-25, 27, 29-31, 36, and 39 recite "obtaining a portion." The Office Action took the position that the term "portion" was unclear from the context of the claim. Applicants respectfully disagree.

The Office Action's argument is, in essence, that "portion" is broad because portion can refer to any amount of a packet up to the whole packet. Applicants respectfully submit that this breadth is not indefiniteness.

The standard for indefiniteness is "insoluble ambiguity." *Energizer Holdings Inc. v. International Trade Commission*, 77 USPQ2d 1625 (CA FC 2006); *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 76 USPQ2d 1741 (CA FC 2005); and *Marley Mouldings Ltd. v. Mikron Industries Inc.*, 75 USPQ2d 1954 (CA FC 2005). In the present application there is no question over ambiguity. Instead, the Office Action appears to

allege that the claims are overly broad. The question of over-breadth is not properly a question of indefiniteness. Moreover, mathematical precision in claims is not required as long as one skilled in the art could have determined the scope. *Modine Mfg. Co. v. Int'l Trade Comm'n*, 75 F.3d 1545, 1557, 37 USPQ2d 1609, 1617 (Fed. Cir. 1996). Accordingly, it is respectfully submitted that the fact that "portion" may broadly include from a bit up to the whole packet does not render the claim indefinite.

Additionally, the Office Action argues that "One of ordinary skill in the art would ... not comprehend the degree of 'obtaining a portion.'" Applicants respectfully submit that the degree is not claimed. No term of degree is used, and, thus, one of ordinary skill in the art would not seek a determination of the measure of such a degree. Paragraphs 0002 and 0027 would serve as a guide, thereby enabling one of ordinary skill in the art to obtain a suitable portion, although, as the Office Action correctly states, paragraph 0027 do not explicitly mention the word "portion." The Office Action mistakenly states that paragraph 0002 does not mention the word "portion," but the Office Action is respectfully directed to lines 3-4 of paragraph 0002.

Accordingly, it is respectfully submitted that claims 1-2, 4, 6-9, 13, 16, 22-25, 27, 29-31, 36, and 39 are definite, and it is respectfully requested that the rejection of claims 1-2, 4, 6-9, 13, 16, 22-25, 27, 29-31, 36, and 39 be withdrawn.

Rejections under 35 U.S.C. 102(b)

Claims 1-46 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,850,521 of Kadambi et al. ("Kadambi"). Applicants respectfully traverse this rejection.

Kadambi issued February 1, 2005. The present application was filed February 19, 2002. Accordingly, it is respectfully submitted that Kadambi is not proper prior art under 35 U.S.C. 102(b), because 35 U.S.C. 102(b) requires (in relevant portion) that "the invention was patented ... in this ... country, **more than one year prior** to the date of application for patent in the United States." (Emphasis added.) Accordingly, because the present application was filed before Kadambi was patented, Kadambi does not qualify as prior art under 35 U.S.C. 102(b). Accordingly, it is respectfully requested that this rejection be withdrawn.

For the Examiner's convenience, the deficiencies of Kadambi with respect to the currently pending claims will be discussed.

Claim 1, upon which claims 2-23 depend, is directed to a method of handling data packets in a network device. The method includes receiving an incoming data packet. The method also includes parsing the incoming data packet to obtain a portion of the incoming data packet. The method further includes comparing said portion with rules stored in a rule table, where each rule of said rules specifies a set of actions. The method additionally includes selecting a match between said portion and a particular rule of said rules. The method also includes executing a particular set of actions specified by said

particular rule. Each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule.

Claim 24, upon which claims 25-46 depend, is directed to a network device for handling data packets. The device includes a rules table, means for receiving an incoming data packet, means for parsing the incoming data packet to obtain a portion of the incoming data packet, and means for comparing said portion with rules stored in said rule table, where each rule of said rules specifies a set of actions. The device also includes means for selecting a match between said portion and a particular rule of said rules and means for executing a particular set of actions specified by said particular rule. Each rule field of said rules includes a mask and a selection flag used by the means for comparing said portion with each rule.

Applicants respectfully submit that Kadambi does not disclose or suggest all of the elements of any of the presently pending claims.

Kadambi generally relates to a network switch. Kadambi, at column 13, lines 55-57, indicates that Ethernet data can be considered to arrive at one of the ports 24a of the Ethernet port interface controller 20a. At column 30, lines 54-56, Kadambi indicates that the arrival of the first sixty-four bytes of a packet can trigger a filtering request being sent to FFP 141. Kadambi goes on to explain that FFP 141 is essentially a state machine driven programmable rules engine, at column 31, lines 20-24. The filters of the FFP 141 can be sixty-four bytes wide and can be applied to an incoming packet. Kadambi

mentions that a sixty-four byte filter mask can be used and applied to any sixty-four bytes of a packet.

Moreover at column 31, lines 50-57, Kadambi notes that SOC 10 includes a filter database that contains multiple filter sets. Two sets of filters can be provided, each containing eight filters and an associate rules table 512 entries deep. The specifics of the filter mask are set forth at column 31, line 58, to column 33, line 13.

As Kadambi explains at column 33, lines 29-33, logic 1411 goes through all filters that have an enable bit set and applies the mask-portion of the filter to the field. The result of that operation is concatenated with the filter number to generate a search key. For example, as illustrated at column 33, lines 55-58, a key can be used to sort the entries in the rule table with "filter value + egress port + egress module + egress module + ingress port + filter select" as the key.

Claims 1 and 24 each recite "wherein each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule." Applicants respectfully submit that Kadambi does not disclose or suggest at least this portion of the claimed invention.

The Office Action cited Kadambi at column 33, lines 35-41 and 55-58. The cited passage, however, does not mention either a "mask" or a "selection flag." The Office Action construed Kadambi's "key" as corresponding to the claimed "mask," and Kadambi's "filter select" as corresponding to the claimed "selection flag."

Kadambi, however, does not indicate that its key functions as a mask, nor has the Office Action provided any analysis to explain how a key can function as a mask. Instead, as explained above, Kadambi does provide a filter mask explained at column 31, line 58, to column 33, line 13. Kadambi's search key, however, is not part of that mask. Thus, it is clear that Kadambi's search key does not correspond to the claimed mask.

Furthermore, claims 1 and 24 recite "a mask ... used in the comparing said portion with each rule." Even if the search key were a mask (not admitted) it is not used in the comparing of a portion of a packet to rules. Instead, as explained at column 33, lines 55-58, the key described there is used to sort entries in the rules table, and as explained at column 33, lines 33-35, the search key described there is used to search for a match to the key in the rules table, not to compare a portion of a packet with a rule.

Moreover, Kadambi does not indicate that the "filter select" is a "selection flag" and the Office Action did not explain how the "filter select" performs the functions of a "selection flag." Kadambi, in fact, describes that the filter select is combined with the filter value, the egress port, and several other items to provide the key discussed at column 33, lines 55-58.

Accordingly, it is respectfully submitted that Kadambi does not and cannot disclose or suggest all of the features of claims 1 and 24, in particular, at least the feature: "wherein each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule." Accordingly, for this additional reason (the

primary reason being that Kadambi is not proper prior art under 35 U.S.C. 102(b)), it is respectfully requested that the rejection of claims 1 and 24 be withdrawn.

Claims 2-23 and 25-46 depend from claims 1 and 24 and recite additional limitations. It is, therefore, respectfully submitted that claims 2-23 and 25-46 recite subject matter that is neither disclosed or suggested in Kadambi. Thus, it is respectfully requested that for this additional reason (the primary reason being that Kadambi is not proper prior art under 35 U.S.C. 102(b)), it is respectfully requested that the rejection of claims 2-23 and 25-46 be withdrawn.

Conclusion

For the reasons explained above, it is respectfully submitted that each of claims 1-46 is definite, even if broad, that Kadambi is not proper prior art under 35 U.S.C. 102(b), and that even if Kadambi were prior art (not admitted), the claims recite subject matter not disclosed or suggested by Kadambi.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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